



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/976,665 | 10/10/2001 | Kohichiro Kodama | KOD69A.001AUS | 1390 |

20995 7590 07/23/2003

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

HARTMANN, GARY S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3671

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,665

Applicant(s)

KODAMA ET AL.

Examiner

Gary Hartmann

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because the lines in Figures 1 and 2 are not uniformly thick and well defined. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3, 5, 9, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaRoche (U.S. Patent 5,128,203). LaRoche discloses a luminescent paint to be placed as desired along a roadway (see abstract). Because a turn signal of an oncoming vehicle would inherently be reflected, the claim limitations are met. Regarding the limitations of installation along a centerline, note that painted strips are commonly painted on the centerline or right side of the road. Regarding the length relative to a vehicle, note that a solid painted road stripe is commonly longer than a vehicle in areas in which the vehicle is to stay to one side of the line. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

Art Unit: 3671

have used the length and positions claimed in order to convey the information that the vehicle is to remain in the lane(s) between the solid lines.

Regarding claims 2 and 9, note that LaRoche teaches this paint to act as a mirror (column 4, lines 45-50).

4. Claims 1, 3, 5, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anders (U.S. Patents 5,665,793 and 5,472,737). Each of these patents discloses a luminescent paint to be placed as desired along a roadway (see abstracts). Because a turn signal of an oncoming vehicle would inherently be reflected, the claim limitations are met. Regarding the limitations of installation along a centerline, note that painted strips are commonly painted on the centerline or right side of the road. Regarding the length relative to a vehicle, note that a solid painted road stripe is commonly longer than a vehicle in areas in which the vehicle is to stay to one side of the line. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the length and positions claimed in order to convey the information that the vehicle is to remain in the lane(s) between the solid lines.

5. Claims 1, 4, 5, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of: Custers et al. (U.S. Patent 6,305,874); Swemer (U.S. Patent 5,042,894); Eigenmann (U.S. Patent 4,993,868); and Wyckoff (U.S. Patent 4,069,787) in view of Johansson (U.S. Patent 6,190,085). Each of these patents discloses an optical fiber placed along a roadway (Custers et al., Figure 1, for example; Swemer, abstract; Eigenmann, Figure 3A, for example; Wyckoff, column 3, lines 29-63, for example). Because a turn signal of an oncoming vehicle would inherently be reflected, the claim limitations are met. Regarding the limitations of installation along a centerline, note that the position in which the device was installed on the roadway is a

Art Unit: 3671

standard practice design consideration. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the apparatus of any of the above devices as claimed in order to convey information in a desired manner. In other words, positioning of a roadway marking device is not patentable because it is within the scope of standard design practice. These devices do not appear to be longer than a vehicle. Johansson teaches installing an optical cable (65) linearly along a roadway in such a manner that it would inherently be longer than a vehicle. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the linear installation of Johansson with the cables of each of Custers et al., Swemer, Eigenmann, or Wyckoff in order to prevent damage by a snow plow, as taught by Johansson.

Response to Arguments

6. Applicant's arguments filed 6/9/2003 have been fully considered but they are not persuasive. The examiner agrees that the patents cited are not necessarily designed to perform the same function as the present invention; however, that they are capable of reflecting the light in the manner claimed meets the claim recitations.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 703-305-4549. The examiner can normally be reached on Monday through Friday, 9am-6pm.

Art Unit: 3671

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 703-308-3870. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

gh
July 3, 2003

A handwritten signature in black ink, appearing to read 'Gary Hartmann', with a long, sweeping horizontal stroke extending to the right.

Gary Hartmann
Primary Examiner
Art Unit 3671